

## REMARKS/ARGUMENTS

Responsive to the Office Action mailed June 26, 2008:

### I. NON-PRIOR ART MATTERS

#### A. The Office Action objected to the drawings

An appropriate amendment is enclosed herein wherein claims 24-26 are cancelled.

### II. PRIOR ART MATTERS

#### A. The Office Action rejected claims 1-18 and 22-26 under 35 USC 102(b) as being anticipated by Gorsuch. Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.<sup>1</sup> “For a prior art reference to anticipate...every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review.”<sup>2</sup> “This standard is very strict. It requires an exact correspondence between the contents of the event and the claim limitations, such that each and every element recited in the claim is present in the anticipatory event.”<sup>3</sup>

In order to anticipate under 35 U.S.C. § 102, “the prior art reference...must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim’.”<sup>4</sup>

As to claim 1, Gorsuch does not disclose:

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<sup>1</sup> *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984); *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1370, 62 U.S.P.Q.2D (BNA) 1865 (Fed. Cir. 2002).

<sup>2</sup> *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)

<sup>3</sup> *Moy's Walker on Patents*, 4<sup>th</sup> ed., § 8.11 (citing *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D(BNA) 1655 (Fed. Cir. 1990))

<sup>4</sup> *Net Moneyin, Inc. v. Versign, Inc.* (Fed. Cir. Appeal No. 2007-1565, decided October 20, 2008) (holding that ‘unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.’)

a flexible membrane designed to come in contact with the skin of an individual and fixed to a shell which is not designed to come in contact with the skin of the individual.

According to paragraphs [0017] and [0019] of the present U.S. Patent Application, a device which contacts the skin of the wearer is uncomfortable and may come into abutment against a bone, altering or even preventing the measurement.

The rigid circular housing 12 of Gorsuch is a shell to which a flexible membrane (diaphragm 38) is affixed as to be flush with the front surface 13 of the shell 12. Col. 3 lines 4-56. Thus, when the flexible membrane 38 comes in contact with the skin, the rigid housing 12 also comes in contact with the skin.

Gorsuch also does not disclose:

- b) a support card upon which at least one sensor is mounted;
- c) a deformable space formed by the flexible membrane and the support card mounted on the membrane;

The sensor 26 of Gorsuch is mounted on the cover plate 16. The cover plate 16 is thus analogously a "support card." The support card 16 is not mounted on the membrane 38. Rather, the membrane 38 is mounted on the guide 22 and the sensor 26 is mounted on the opposite end of the guide 22. The space 36 of Gorsuch is not formed by the membrane 38 and the support card 16.

Thus, Gorsuch does not satisfy all limitations of claim 1. Therefore claim 1 is patentable over Gorsuch.

Claims 2-18 contain additional elements and/or limitations beyond allowable claim 1 and are also allowable.

Further as to claim 2, the Examiner has not provided an explicit disclosure within the four corners of Gorsuch that, as the Examiner claims, "the membrane 38 has at least two areas of different rigidities due to stretching of the membrane during assembly."

Further as to claim 10, the Examiner has not provided an explicit disclosure within the four corners of Gorsuch that, as the Examiner claims, “the thickness of the peripheral area is less than the thickness of the main contact area.”

Further as to claim 15, the Examiner has not provided an explicit disclosure within the four corners of Gorsuch that, as the Examiner claims, “the substance 36 is a dielectric material.”

B. The Office Action rejected claims 19-21 and 27 under 35 USC 103(a) as being unpatentable over Gorsuch in view of Stivoric.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>5</sup> If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.<sup>6</sup>

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.<sup>7</sup>

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

1. The cited prior art does not teach or suggest all the claim limitations.

Claims 19-21 and 27 contain additional elements and/or limitations beyond allowable claim 1 and are also allowable.

C. The Office Action rejected claims 29-34 under 35 USC 103(a) as being unpatentable over Gorsuch in view of Scholz.

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<sup>5</sup>MPEP Sec. 2142.

<sup>6</sup> Id.

<sup>7</sup>Id. (emphasis supplied)

As to claim 29, the references do not disclose the step of connecting together a membrane and the support, defining a deformable space.

As previously discussed, the membrane 38 of Gorsuch is not connected to the support 16 and the deformable space is not defined by the membrane 38 and the support 16.

Claim 29 is therefore allowable.

Claims 30-34 contain additional elements and/or limitations beyond allowable claim 29 and are also allowable.

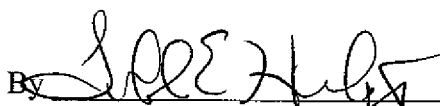
The enclosed amendments are fully supported by the original disclosure and thus do not constitute new matter.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 02-3732.

Respectfully submitted,

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By   
Gerald E. Helget (Reg. No. 30,948)  
Nelson R. Capes (Reg. No. 37,106)  
BRIGGS AND MORGAN, P.A.  
2200 IDS Center, 80 South Eighth Street  
Minneapolis, MN 55402  
Telephone: 612-977-8480  
Facsimile: 612-977-8650